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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,286	11/30/2001	Eric Aerts	9971-005	2124
20583	7590	03/29/2005	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			TORRES VELAZQUEZ, NORCA LIZ	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 03/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,286

Applicant(s)

AERTS, ERIC

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 48-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Arguments

1. Applicant noted that the Rabinowicz et al. (US 6,645,040) reference filed November 9, 2001 has an effective filing date that is later than that of present application. The present application claims priority to Provisional Patent Application No. 60/330,119 filed on October 16, 2001. The rejection of claims 1, 4-9 and 12-24 over Rabinowicz et al. is withdrawn in view of the above.
2. Applicant's arguments with regards to rejoining of withdrawn claims have been fully considered but they are not persuasive. The restriction requirement is maintained and it is further noted that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).
3. Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the new ground(s) of rejection.
4. It is further noted on the record that the presently claimed film does not preclude the use of an open net-like film such as the one taught in Smith. The film as claimed is not limited to a non-porous film or a monolithic layer film. The Specification of the present invention does not define the term "film" as a non-porous film or a monolithic layer film. Therefore, it is still the Examiner's interpretation that the film structure disclosed by Smith would read on the presently

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claimed film. However, a secondary reference is provided herein to provide a film (different from a web of an open net-like film), and in view of the amendment to the claims, the Examiner now relies on the teachings of BATTREALL to provide the claimed film comprising polyurethane.

5. With regards to the objection to the drawings, Applicants indicated that the third layer of woven, stretch fabric is illustrated in Figures 11 and 12, however, the drawings fail to show the spatial relationship of such layer in the laminate.

6. Changes to figures 1-3 and 6 of the drawings are noted.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "*third layer of woven, stretch fabric*" must be shown in the laminate structure or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

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Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over BATTREALL (US 5,234,523).

BATTREALL discloses a process for laminating a layer of material to a substrate used of contoured products. (Col. 1, lines 8-13) The reference teaches laminating a substrate (made from materials such as cotton), to a gas permeable layer (knitted or woven material) by means of an adhesive layer. The adhesive may be in the form of a liquid, a powder, a film or a web, and may be applied to the substrate surface in any of the conventional methods for doing so. The reference discloses the use of heat-activated adhesives such as polyolefins, polyesters, polyurethane, etc. (Col. 2, lines 14-55) It is noted that the term “substrate” is defined as a fiber,

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fiber assembly, yarn, fabric or film to which another material is applied. (Fairchild's Dictionary of Textiles, 7th edition p.551) Since the reference discloses the use of materials such as cotton, it is the Examiner's position that equating the term "substrate" to fabric is an appropriate interpretation of the term in the context of the art of BATTREALL.

It is the examiner's position that the laminate of BATTREALL is identical to or only slightly different than the claimed laminate prepared by the method of the claim(s), because both laminates are formed by two layers of fabric bonded by a polyurethane film adhesive in between. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The BATTREALL reference either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the BATTREALL et al. reference.

Claim Rejections - 35 USC § 103

10. Claims 1-14, 27, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over SMITH et al. (US 5,447,462) in view of BATTREALL (US 5,234,523) and further evidenced by PRUNESTI (US 4,776,916).

Smith is concerned with the creation of a laminated fabric used in the construction of a brassiere. Smith teaches two fabrics laminated together by an open net-like film of heat sensitive adhesive. (Abstract) The fabrics are laminated by using heat and pressure. (Refer to Column 9) The reference teaches the fabric to have a cup. (Figure 13). Smith teaches applicant's claimed openings. (Figure 11) Smith further teaches the use of additional layers laminated in the same manner as the first two layers (Col. 5, lines 18-25). The reference further teaches the fabrics to be elastic and woven. (Col. 5, lines 24-34)

The Smith reference provides the fabric laminate structure of claim 1 that comprises a first fabric, a second fabric and a heat sensitive adhesive layer in between. However, it fails to teach a film (different from a web of an open net-like film), that comprises a polyurethane. BATTREALL discloses a process for laminating a layer of material to a substrate used of contoured products. (Col. 1, lines 8-13) The reference teaches laminating a substrate (made from materials such as cotton), to a gas permeable layer (knitted or woven material) by means of an adhesive layer. The adhesive may be in the form of a liquid, a powder, a film or a web, and may be applied to the substrate surface in any of the conventional methods for doing so. The reference discloses the use of heat-activated adhesives such as polyolefins, polyesters, polyurethane, etc. (Col. 2, lines 14-55) With regards to the thickness of the adhesive layer, it is noted that the BATTREALL reference discloses that the amounts of adhesive will vary

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depending on the physical characteristics of the material to be bonded. (Col. 2, lines 49-52 Applicant's ranges for the limitation of the thickness of the adhesive layer are broad and encompass typical values that are found in the prior art. Further each of the elements are recognized as result effective variables in this field of endeavor and it has been held that discovering optimum values would have been or result effective variables involves only routine experimentation. This is evidenced by the PRUNESTI et al. (US 4,776,916) reference which uses adhesive materials garments with typical thickness values for garments in which the thickness of the adhesive material varies depending on the amount of support intended. (Refer to Col. 9, lines 44-62)

Since both references are directed to laminates, the purpose disclosed by BATTRELL et al. would have been recognized in the pertinent art of SMITH.

SMITH discloses the claimed invention except that it uses a polyamide heat sensitive web of an open net-like film instead of a polyurethane heat sensitive adhesive film, BATTRELL shows that polyurethane film is an equivalent structure known in the art. Therefore, because these two references were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a polyamide web of an open net-like film for a polyurethane film.

It is the examiner's position that the laminate from the combination of SMITH and BATTRELL is identical to or only slightly different than the laminate claimed prepared by the method of the claim(s), because both laminates are formed by two layers of fabric bonded by a polyurethane film adhesive in between. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The

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patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The SMITH in view of BATTRELL either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the prior art applied herein.

11. Claims 15-24 and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over SMITH et al. (US 5,447,462) and BATTREALL (US 5,234,523) and further evidenced by RUDY (US 5,042,176).

While BATTREALL is silent to the type of polyurethane material used, the use of an ether-based polyurethane film would have been obvious since this type of material is known for its hydrolysis stability as evidenced by RUDY (Col. 13, lines 24-52) and one having ordinary skill in the art of polyurethane film materials would use an ether-based polyurethane film in the production of materials that are highly exposed to water and moisture motivated by the desire of producing a material that is stable in water and moisture environments.

12. Claim 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and BATTREALL as applied above, and further in view of Kollmanthaler et al. (US 5,967,876).

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Smith fails to teach the use of an insert wire. Kollmanthaler is concerned with the creation of a brassiere. Kollmanthaler teaches the use of an insert wire. (Abstract) It would have been obvious to a person having ordinary skill in the art to utilize an insert wire in the bra of Smith. Such a combination would have been motivated by the desire to provide further support to the wearer of the garment, for example, the use of insert wires will be useful in enhancing the support the brassiere for a wearer with full figure. It is the Examiner's position that the use of an insert wire to provide an enhanced support would be recognized in the art of Smith.

13. Claims 28-31 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and BATTREALL as applied above, and further in view of Tedeschi et al. (US 5,984,762).

Smith teaches the use of a strap but fails to teach cushioning said strap. Tedeschi is concerned with the creation of a bra strap. Tedeschi teaches applicant's claimed cushioning layers. (Abstract).

With respect to the process limitations of prelaminating the adhesive, it is the Examiner's it is the examiner's position that the laminate fabric and brassiere created by the combination of Smith and Tedeschi is identical to or only slightly different than the presently claimed laminate and brassiere prepared by the method of the claim(s), because both structures have a first fabric laminated to a second fabric by an adhesive in between. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the

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claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

BALIT et al. (US 5,406,646) – discloses a stretchable and water resistant laminated fabric composition that comprises two layers of stretchable fabrics bonded together by a heat activated adhesive comprising a urethane polymer suspended in a toluene containing solvent. (Abstract)
[not a polyurethane film adhesive]

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Norca L. Torres-Velazquez
Examiner
Art Unit 1771

March 24, 2005